

ESTTA Tracking number: **ESTTA452780**

Filing date: **01/24/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Academy of Motion Picture Arts and Sciences		
Entity	Corporation	Citizenship	California
Address	8949 Wilshire Boulevard Beverly Hills, CA 90211 UNITED STATES		

Attorney information	Jolie Apicella Quinn Emanuel Urquhart & Sullivan LLP 51 Madison Ave 22nd Floor New York, NY 10010 UNITED STATES jolieapicella@quinnemanuel.com, claudiabogdanos@quinnemanuel.com, ulanaholubec@quinnemanuel.com, davidquinto@quinnemanuel.com Phone:212-849-7000
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Registration Subject to Cancellation

Registration No	3974726	Registration date	06/07/2011
Registrant	Alliance of Professionals & Consultants, Inc. 8200 Brownleigh Drive Raleigh, NC 27617 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2009/03/13 First Use In Commerce: 2009/03/13 All goods and services in the class are cancelled, namely: Providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of business consultation and information technology
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Grounds for Cancellation

The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
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Attachments	4566773_1_Petition.PDF (25 pages)(1479491 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Jolie Apicella/
Name	Jolie Apicella
Date	01/24/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,974,726
Registered June 7, 2011
Mark: OSCAR

ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES,

The Academy,

-against-

ALLIANCE OF PROFESSIONALS AND
CONSULTANTS, INC.,

Respondent.

Cancellation No. _____

PETITION FOR CANCELLATION

TO THE COMMISSIONER FOR TRADEMARKS:

Petitioner Academy of Motion Picture Arts and Sciences (“the Academy”) believes it is, and will continue to be, damaged by the existence of Registration Number 3,974,726 for the mark OSCAR and hereby petitions for cancellation of the same pursuant to Section 14(1) of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1064(1).

1. The Academy is a corporation duly organized and existing under the laws of the State of California, with its principal place of business at 8949 Wilshire Boulevard, Beverly Hills, California 90211.

2. Respondent Alliance of Professionals & Consultants, Inc. is, upon information and belief, a corporation organized and existing under the laws of North Carolina, with its principal place of business at 8200 Brownleigh Drive, Raleigh, North Carolina.

3. For many years, and long before March 13, 2009, the date of first use in commerce listed in the subject trademark registration, and January 6, 2011, the filing date of Respondent's trademark application, the Academy has used the trademarks OSCAR and OSCARS, and variations thereof (collectively, the "OSCAR Marks"), in connection with its business of recognizing outstanding achievement in the motion-picture industry, and related goods and services.

4. The Academy was founded in 1927 by a group of 36 film industry leaders, who numbered among them Cecil B. Demille, Mary Pickford, Jack Warner and Douglas Fairbanks, for the purpose of advancing the motion picture arts and sciences by promoting cultural, educational and technological achievements. As an incentive for members of the industry to strive toward this goal and as a means of recognizing persons who make outstanding contributions in their respective creative fields, the Academy presents annual "Awards of Merit," known to the public as the Oscar® Awards or the "Oscars."

5. For decades, the Academy has used its OSCAR Marks and other marks for educational and entertainment services, library and reference services, and theatrical exhibitions of motion pictures. The Academy and its sponsors spend millions of dollars annually to advertise and promote the presentation of the Oscar® Awards and associated products and services through various media, including television, the internet, radio, newspapers and magazines, and other means.

6. Over the years, the presentation of the Oscar® Awards has become tremendously popular, generating much public anticipation and excitement. The Oscar® Awards are presented during the internationally televised “Academy Awards” program, viewed each year by hundreds of millions of viewers in over 200 countries and territories, making it the most widely watched live entertainment event in the world. In this country, the award Oscar® presentations have been televised for over half a century. Indeed, a video presentation concerning trademarks prepared by the USPTO identified the Oscar statuette as one of the world’s most famous marks.

7. As a result of the substantial use, advertisement, and promotion of the Oscar® Awards and their presentation by the Academy, as well as the international media attention and the resulting renown of the awards ceremony, The Academy has gained very valuable goodwill and strong customer recognition worldwide in its famous OSCAR Marks.

8. In addition to its far-reaching common-law rights in the OSCAR Marks, the Academy owns, *inter alia*, the following federal trademark registrations:

Number	Mark	Goods/Services (Partial List)	Date of First Use in Commerce	Registration Date
1096990	OSCAR	Entertainment and educational service – namely, telecasts in connection with the recognition of distinguished achievement in the motion picture industry; library and reference services; theatrical exhibitions of motion pictures, in International Class 41	4/2/1974	7/18/1978

Number	Mark	Goods/Services (Partial List)	Date of First Use in Commerce	Registration Date
1118751	OSCAR	Books and supplements thereto, pamphlets, brochures, dealing with the motion picture industry and personalities; press kits containing detailed information as to broadcats [<i>sic</i>] and presentations of awards, including chronological list of events, program format, personalities involved, motion pictures involved and other elements comprising the broadcasting of motion picture awards, in International Class 16	10/4/1974	5/22/1979
1528890	OSCARS	Entertainment services, namely, telecasts in connection with the recognition of distinguished achievement in the motion picture industry, in International Class 41	3/30/1987	3/7/1989
1996585	OSCAR	Sweatshirts; jackets; T-shirts; and, caps, in International Class 25	4/1989	8/27/1996
2021582	OSCAR	Prerecorded videotapes featuring entertainment relating to motion pictures and award ceremonies, in International Class 09	2/1/1992	12/10/1996
2029445	OSCAR NIGHT	Educational and entertainment services rendered through the medium of an annual live, televised program dealing with motion pictures, in International Class 41	1987	1/14/1997
2341104	SUNDAY AT THE OSCARS	Educational and entertainment services rendered through the medium of an annual live, televised program dealing with motion pictures, in International Class 41	January 1999	4/11/2000

9. The Academy's above-referenced trademark registrations are valid, subsisting, and incontestable, and, as the owner of these registered marks, the Academy has the rights to their exclusive use.

10. The Academy also uses its OSCAR Marks on several of its websites, including <www.oscar.com>, <www.oscars.org>, <www.academyawards.com>, <www.youtube.com/Oscars>, and <www.facebook.com/TheAcademy>.

11. In addition, the Academy holds several federal registrations for the design of the Oscar statuette, which is famous and recognizable worldwide as a symbol both of the actual Awards of Merit and the much anticipated ceremony at which these awards are presented. In advertising and marketing the Awards of Merit event, the Oscar statuette is often depicted alongside the OSCAR Marks. Attached hereto as Exhibit A are true and correct copies of the federal registrations for the statuette design, as well as screen shots from the Academy's websites showing use of the OSCAR Marks together with the Oscar statuette.

12. The OSCAR Marks are so widely recognized, both nationally and internationally, that they have become famous and world-renowned marks. The public universally associates the OSCAR Marks with the award presented to the winners of the Academy's annual Awards of Merit. The OSCAR Marks are unquestionably linked in the public mind with the Academy and its Awards of Merit.

13. The Academy's OSCAR Marks were famous at least as of, and long before, March 13, 2009, the alleged date of first use in commerce of, and January 6, 2011, the filing date of, the mark sought to be cancelled herein.

14. The Academy's OSCAR Marks were distinctive at least as of, and long before, March 13, 2009, the alleged date of first use in commerce of, and January 6, 2011, the filing date of, the mark sought to be cancelled herein.

15. The Academy is a venerable and important industry body, responsible for encouraging cultural, educational and technological advances. The Academy's esteem is based on its reputation for conferring the Oscar® Award only on those who have shown outstanding achievement in their fields. The Oscar® Award would not be a credible, highly prized award if

the public and trade believed that persons other than an Academy Award of Merit winner could receive an Oscar® Award.

16. Respondent is the current listed owner of Registration No. 3,974,726 for the designation OSCAR in connection with “[p]roviding recognition and incentives by the way of awards and contests to demonstrate excellence in the field of business consultation and information technology,” in International Class 41 (“Respondent’s Mark”).

17. Respondent’s Mark is identical to several of Petitioner’s OSCAR Marks, and nearly identical to several others.

18. Respondent filed its application for the registration sought to be cancelled herein on January 6, 2011, almost 40 years after Petitioner first used, and obtained federal trademark registrations for, the mark OSCAR the in the context of conferring awards.

19. Respondent’s application to register, Respondent’s use, and Respondent’s registration of the OSCAR designation for awards are without Petitioner’s consent, authorization, or license.

20. Respondent is using its OSCAR designation in conjunction with the word “Award,” which highlights Respondent’s bad faith and serves to increase the likelihood of confusion. Attached hereto as Exhibit B is a true and correct printout from Respondent’s webpage referencing winners of “2010 OSCAR” and “2011 OSCAR Award.”

21. The Academy is, and will continue to be, damaged by the existence of Registration No. 3,974,726, because said registration is so deceptively similar to the Academy’s famous OSCAR Marks as to dilute the OSCAR Marks and harm the Academy’s reputation, and

is likely to cause confusion among the public as to the origin or affiliation of Respondent's services.

22. Cancellation of Respondent's mark should be granted pursuant to Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and Trademark Board Manual of Procedure § 303.01 (2011), on the grounds that the Academy is, and will continue to be, damaged by said registration because the registration dilutes the distinctive and famous quality of the Academy's OSCAR Marks.

23. Cancellation of Respondent's mark should be granted pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Respondent's use of said registration falsely suggests a connection between Respondent and the Academy, to the damage of the Academy.

24. Cancellation of Respondent's mark should be granted pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that said registration so resembles The Academy's OSCAR Marks used consistently by the Academy in the United States, as to be likely, when used on or in connection with the goods and services identified in the registration, to cause confusion, or to cause mistake, or to deceive, with consequent injury to the Academy and to the public.

WHEREFORE, the Academy respectfully requests that this Petition for Cancellation be sustained and that Registration No. 3,974,726 be cancelled.

Pursuant to 37 C.F.R. § 2.6(a)(16), please charge Deposit Account Number 50-5708 the requisite amount of three hundred dollars (\$300.00) to cover the statutory fee for filing

a petition for cancellation in one International Class. Please also charge any additional amounts to Deposit Account Number 50-5708.

Respectfully submitted,

Dated: January 24, 2012

By: Claudia Bogdanos /JA

QUINN EMANUEL URQUHART
& SULLIVAN, LLP
Claudia T. Bogdanos
Ulana Holubec
51 Madison Avenue, 22nd Floor
New York, NY 10010
Telephone: (212) 849-7255
Facsimile: (212) 849-7100

QUINN EMANUEL URQUHART
& SULLIVAN, LLP
David W. Quinto
865 South Figueroa Street, 10th Floor
Los Angeles, CA 90017-2543
Telephone: (213) 443-3000
Facsimile: (213) 443-3100

*Attorneys for Petitioner Academy of Motion
Picture Arts and Sciences*

CERTIFICATE OF SERVICE

I certify that on the 24th day of January, 2012, I caused a true copy of the attached Petition for Cancellation to be served on the Alliance of Professionals & Consultants, Inc., by sending same via overnight mail to Respondent at the following address:

8200 Brownleigh Drive
Raleigh, NC 27617-7423


Jolie Apicella

Exhibit A

Int. Cl.: 16, 41

Prior U.S. Cl.: 38, 107

United States Patent Office

Reg. No. 1,028,635

Registered Dec. 30, 1975

**TRADEMARK
SERVICE MARK**
Principal Register



Academy of Motion Picture Arts and Sciences (California
corporation)
9038 Melrose Ave.
Hollywood, Calif.

For: BOOKS, PAMPHLETS, BROCHURES AND
PRESS KITS ISSUED FROM TIME TO TIME, in
CLASS 16 (U.S. CL. 38).

First use May 16, 1929; in commerce January 1937.

For: EDUCATIONAL AND ENTERTAINMENT
SERVICES RENDERED THROUGH THE MEDIUM
OF AN ANNUAL LIVE, TELEVISION PROGRAM
DEALING WITH MOTION PICTURES, in CLASS 41
(U.S. CL. 107).

First use May 16, 1929; in commerce Mar. 19, 1953.

Ser. No. 33,493, filed Oct. 2, 1974.

Int. Cls.: 16 and 41

Prior U.S. Cls.: 38 and 107

United States Patent and Trademark Office
10 Year Renewal

Reg. No. 1,028,635
Registered Dec. 30, 1975
Renewal Term Begins Dec. 30, 1995

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**



ACADEMY OF MOTION PICTURE
ARTS AND SCIENCES (CALIFORNIA
CORPORATION)
8949 WILSHIRE BOULEVARD
BEVERLY HILLS, CA 90211

FOR: BOOKS, PAMPHLETS, BRO-
CHURES AND PRESS KITS ISSUED
FROM TIME TO TIME, IN CLASS 16
(U.S. CL. 38).

FIRST USE 5-16-1929; IN COMMERCE
1-0-1937.

FOR: EDUCATIONAL AND ENTER-
TAINMENT SERVICES RENDERED
THROUGH THE MEDIUM OF AN
ANNUAL LIVE, TELEVISION PRO-
GRAM DEALING WITH MOTION PIC-
TURES, IN CLASS 41 (U.S. CL. 107).

FIRST USE 5-16-1929; IN COMMERCE
3-19-1953.

SER. NO. 73-033,493, FILED 10-2-1974.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 31, 1995.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. CL: 16, 41

Prior U.S. CL: 38, 107

United States Patent Office

Reg. No. 1,028,635

Registered Dec. 30, 1975

**TRADEMARK
SERVICE MARK
Principal Register**



Academy of Motion Picture Arts and Sciences (California
corporation)
9038 Melrose Ave.
Hollywood, Calif.

For: BOOKS, PAMPHLETS, BROCHURES AND
PRESS KITS ISSUED FROM TIME TO TIME, in
CLASS 16 (U.S. CL. 38).

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SERVICES RENDERED THROUGH THE MEDIUM
OF AN ANNUAL LIVE, TELEVISION PROGRAM
DEALING WITH MOTION PICTURES, in CLASS 41
(U.S. CL. 107).

First use May 16, 1929; in commerce Mar. 19, 1953.

Ser. No. 33,493, filed Oct. 2, 1974.

Int. Cl.: 9

Prior U.S. Cl.: 21

United States Patent and Trademark Office

Reg. No. 1,895,980

Registered May 30, 1995

**TRADEMARK
PRINCIPAL REGISTER**



ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES (CALIFORNIA CORPORATION)
8949 WILSHIRE BOULEVARD
BEVERLY HILLS, CA 90211

FIRST USE 3-0-1992; IN COMMERCE
3-0-1992.

OWNER OF U.S. REG. NO. 1,028,635.

FOR: PRE-RECORDED VIDEO TAPES FEA-
TURING ENTERTAINMENT RELATING TO
MOTION PICTURES, IN CLASS 9 (U.S. CL. 21).

SER. NO. 74-477,109, FILED 1-6-1994.

KEVIN PESKA, EXAMINING ATTORNEY

Int. Cl.: 25

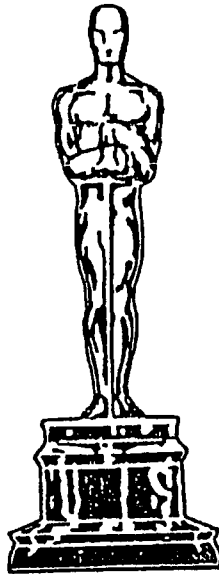
Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 1,960,182

Registered Mar. 5, 1996

**TRADEMARK
PRINCIPAL REGISTER**



ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES (CALIFORNIA CORPORATION)
8949 WILSHIRE BOULEVARD
BEVERLY HILLS, CA 90211

FIRST USE 3-0-1989; IN COMMERCE
4-0-1989.

SER. NO. 74-650,049, FILED 3-22-1995.

FOR: SWEATSHIRTS; JACKETS; T-SHIRTS;
AND, CAPS, IN CLASS 25 (U.S. CLS. 22 AND
39).

K. MARGARET LE, EXAMINING ATTORNEY

Int. Cl.: 25

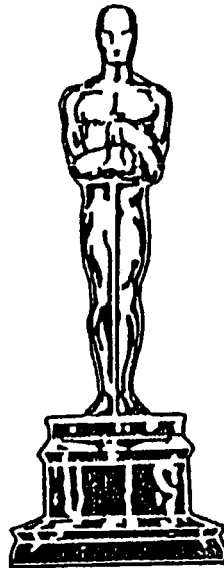
Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 1,960,182

Registered Mar. 5, 1996

**TRADEMARK
PRINCIPAL REGISTER**



**ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES (CALIFORNIA CORPORATION)
8949 WILSHIRE BOULEVARD
BEVERLY HILLS, CA 90211**

**FIRST USE 3-0-1989; IN COMMERCE
4-0-1989.**

SER. NO. 74-650,049, FILED 3-22-1995.

**FOR: SWEATSHIRTS; JACKETS; T-SHIRTS;
AND, CAPS, IN CLASS 25 (U.S. CLS. 22 AND
39).**

K. MARGARET LE, EXAMINING ATTORNEY

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,112,107

United States Patent and Trademark Office

Registered Nov. 11, 1997

**TRADEMARK
PRINCIPAL REGISTER**



ACADEMY OF MOTION PICTURE (CALIFOR-
NIA CORPORATION)
ARTS AND SCIENCES
8949 WILSHIRE BOULEVARD
BEVERLY HILLS, CA 90211

FOR: PRE-RECORDED CD-ROMS FEATUR-
ING ENTERTAINMENT RELATING TO
MOTION PICTURES AND AWARD CEREMO-

NIES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND
38).

FIRST USE 6-0-1993; IN COMMERCE
6-0-1993.

OWNER OF U.S. REG. NOS. 1,028,635 AND
1,895,980.

SER. NO. 75-180,095, FILED 10-11-1996.

SIRINA TSAI, EXAMINING ATTORNEY

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50

Reg. No. 2,498,269

United States Patent and Trademark Office

Registered Oct. 16, 2001

**TRADEMARK
PRINCIPAL REGISTER**



ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES (CALIFORNIA CORPORATION)
8949 WILSHIRE BOULEVARD
BEVERLY HILLS, CA 90211

OWNER OF U.S. REG. NOS. 1,028,635, 2,112,107
AND OTHERS.

FOR: PRINTED MATTER, NAMELY, DIRECTOR-
IES FEATURING INFORMATION RELATING TO
THE EMPLOYMENT OF TALENT IN THE MOTION
PICTURE, TELEVISION AND RADIO INDUSTRIES,
IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

THE MARK CONSISTS OF A STYLIZED MALE
FIGURE AND DESIGN.

SER. NO. 76-145,599, FILED 10-12-2000.

FIRST USE 0-0-1937; IN COMMERCE 0-0-1937.

BERYL GARDNER, EXAMINING ATTORNEY



THE ACADEMY
OF MOTION PICTURE ARTS AND SCIENCES

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Oscar's Passport

It begins on the Oscar stage. But the impact of the Academy Awards is felt around the world – just like the impact of film itself.

Over the years, the Academy has honored many international filmmakers. The telecast, seen by a global audience of hundreds of millions of viewers, has taken on many international elements. And, of course, there is the Best Foreign Language Film category. Since 1956, this category has honored excellence, and – perhaps more importantly – made audiences aware of the visionary films and filmmakers of other countries, whether close by or far away.

Take a journey through Academy Award history and around the globe with videos, rare photos and more featuring the honorees, films and extraordinary artwork that has made Oscar such a distinguished world traveler.



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OSCAR WINNERS FROM ALL OVER THE WORLD

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Paramount's Movie Milestones: A



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#36

GREAT OSCAR MOMENTS: MONA LISA SMILES

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Video Highlights



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Just Released: *The Digital Dilemma 2*

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OSCAR HISTORY

O

1DAY
UNTIL NOMINATIONS

John Wayne 1970


John Wayne wins his only Oscar for True Grit.

What History Will Be Made This Year? Nominations Announced Jan. 24 / ►


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Exhibit B



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December 23, 2011 - Greg Tomko wins APC 2011 OSCAR Award

June 24, 2011 - APC Announced as Top Small Business

December 17, 2010 - Theresa Yoss wins 2010 OSCAR

December 1, 2010 - Eric Larsen, former IBM regional sales director, joins APC

November 16, 2010 - Roy Roberts appointed to federal advisory council

November 3, 2010 - APC CEO appointed to US Commerce Dept. Advisory Council

July 8, 2009 - APC Launches Aging Workforce Solutions

May 28, 2009 - APC participates in Accenture's Mentoring Program

April 20, 2009 - APC Launches New Branding Image and Website

March 20, 2009 - APC Receives 2009 Business Champion Award

August 27, 2008 - MBDA National Service Firm of the Year

August 26, 2008 - MBDA MED Southeast Regional Award

October 11, 2007 - Supplier of the Year

April 10, 2007 - New Offices

July 26, 2004 - Top 50 Influential Minority

May 12, 2004 - ISO Certification

November 10, 2003 - Triangle Fast 50

November 4, 2003 - SBA Nomination

September 23, 2003 - Fast Tech 50 Award

July 23, 2003 - GSA Schedule

July 22, 2003 - Celebrating 10 Years

December 23, 2002 - Purple Squirrel

October 11, 2002 - Inc 500 Award

August 30, 2002 - Fast Tech 50 Award

July 2, 2002 - Native American

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